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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,909	02/20/2002	Christoph Schwemler	Mo6846/LeA 33,663	8764
157	7590	03/02/2004	EXAMINER .	
BAYER POLYMERS LLC 100 BAYER ROAD PITTSBURGH, PA 15205			PHASGE, ARUN S	
			ART UNIT	PAPER NUMBER
			1753	
DATE MAILED: 03/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/009,909	Applicant(s) SCHWEMLER ET AL. 	
	Examiner Arun S. Phasge	Art Unit 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shigeniwa et al. in view of Sanyo of record for reasons of record.

Since the subject matter of claim 2 has been incorporated into claim 1, the rejection has been modified to include the teachings of the Sanyo reference, that tap water would inherently contain at least the amount of common salt claimed (see page one of the machine translation).

Claims 3, 4, 8 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shigeniwa in view of Sanyo as applied to claims above, and further in view of Bennett or Mucenieks of record for reasons of record.

Response to Arguments

Applicant's arguments filed 11/20/03 have been fully considered but they are not persuasive.

Applicants argue that the combination of the Sanyo patent teaching the electrolysis of tap water with the disclosure of Shigeniwa patent discloses nothing

relative to water having a high salt content and therefore adds to Shigeniwa nothing that is presently relevant.

The Sanyo patent is cited to show that tap water inherently contains enough chloride, that electrolysis of said tap water would produce water that has sterilization properties. If the tap water has a concentration of chloride below the claimed range, such a sterilization producing water could not be obtained. Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention that tap water would inherently have the claimed amount of chloride, because the Sanyo patent teaches that tap water when electrolyzed will produce sterilization.

Applicants argue that "it is not seen how or why any of the secondary references may be rationally combined with Shigeniwa for any purpose much less for the purpose of denying patentability to the claims at issue."

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 U.S.P.Q. 607. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references

is what the combination of disclosures taken, as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 U.S.P.Q. 114; *In re McLaughlin*, 170 U.S.P.Q. 209. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545.

All that is required to show obviousness is that the applicant "make his claimed invention merely by applying knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor." *In re Winslow*, 151 U.S.P.Q. 48 CCPA (1966).

The claims rejected by the present combination are directed to electrolysis of "common salt" or brine containing solutions that have been purified by the addition of oxidants. The secondary references were cited to show the skill of the ordinary artisan and to demonstrate the knowledge clearly present in the prior art. The two references teach the electrolysis of brine or "common salt" to produce chlorine, wherein the brine has been treated by the addition of oxidants to produce purified brine (see Abstract or col. 1, lines 60-68 of Bennett and the abstract and claims 1-12 of Mucenieks).

Consequently, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the

disclosure of the Shigeniwa to use the oxidant purified tap water containing "common salt" with the teachings of the Bennett and Mucenieks, because the Bennett and Mucenieks patents teach that the oxidant purified water containing common salt is beneficial in the production of chlorine.

Conclusion

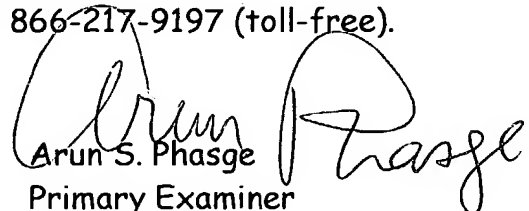
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (571) 272-1345. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Arun S. Phasge
Primary Examiner
Art Unit 1753